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52

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,281	06/27/2001	Kenneth H. Abbott	29443-8020US3	5537
500	7590	05/25/2005	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092			HAILU, TADESSE	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/894,281

Applicant(s)

KENNETH H. ABBOTT ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 66-91, 93-106, 108-115, 117, 119-133 and 135-138 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 66-91, 93-106, 108-110, 115, 117, 119-131 and 135-138 is/are allowed.
- 6) ☐ Claim(s) 111, 114, 132 and 133 is/are rejected.
- 7) ☐ Claim(s) 112 and 113 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/16/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is in response RCE submitted on February 16, 2005.
2. The Information Disclosure Statement submitted on February 16, 2005 have been considered, initialized and entered into the file.
3. Claims 66-91, 93-106, 108-115, 117, 119-133 and 135-138 are now pending.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 111, 114, and 132-133 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to claim 111, the preamble recites "a computing device" which is not necessarily hardware, and the remainder of the claim recites "a receiver component" and "a group state component", which are software components. Thus, the alleged "computing device" does not implemented in hardware, the claim is non-statutory and is rejected under **35 USC § 101** as not being tangible.

With regard to claim 114, the preamble recites "a computing device" which is not necessarily a hardware, and the remainder of the claim recites "means for receiving an indication", "means for determining multiple characterization modules", and "means for gathering current information" In the specification, the examiner did not find any equivalent hardware for the above means plus functions. Since the alleged "computing

device” does not necessarily include hardware, thus, the claim is non-statutory and is rejected under **35 USC § 101** as not being tangible.

With regard to claim 132, even though the preamble recites “a portable device”, hardware, but the remainder of the claim recites nothing about the alleged portable device, instead of reciting a hardware component of the alleged “portable device”, the remainder of the claim rather recites software modules, i.e., “an input module” and “a group context modeler”. The claim is at best directed to an arrangement of software, *per se*, and is non-statutory, thus, the claim is rejected under **35 USC § 101** as not being tangible.

#### ***Allowable Subject Matter***

5. For similar reasons given in the previous Office action, Claims 66-91, 93-106, 108-110, 115, 117, 119-131 and 135-138 are allowed.
6. Claims 111, 114, 132 and 133 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.
7. Claims 112 and 113 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### **CONCLUSION**

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts

Art Unit: 2173

to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

9. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner Tadesse Hailu  
Art Unit 2173 - Operator Interface  
5/19/05

A handwritten signature in cursive script, appearing to read "Tadesse Hailu", written in black ink.